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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,833	12/04/2003	Roger Lok	87028SMR	7419

7590

10/13/2005

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EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/727,833

Applicant(s)

LOK ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9 and 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

This is in response to Papers filed on 26 July 2005.

- I. In view of the showings under Rude 132 and arguments that complex inorganic-SCN does not release inorganic-S as claimed. Accordingly, the applied primary reference with respect to Stauffer et al (2,472,631) has been withdrawn. A complex inorganic-SCN is not considered.
- II. The English language translation of JP 4-125629 has a complex inorganic-SCN. The English language translation of DE 198 30 439 has SCN leaving group as that in Loria et al (3,253,924). The English language translation does not the SCN group.
- III. The record shows that applicants elect compound 1 on page 10 of the specification on 03 March 2005 being acknowledged. The elected species of compound 1 has been considered and searched. The consideration and search are extended to the applied species. Others have not been considered, searched or examined until all of the applied species are overcome.

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IV. Claim 1-2, 4-9, 11-14 and 20 with respect to the applied species are rejected under 35 U.S.C. 102(b) as being anticipated by Renner et al (DE 37 30 557) by the English language translation.

Renner et al disclose and teach a silver halide photographic material comprising a support having thereon an silver halide emulsion layer containing to more than 99 mol% silver chloride and from 1 to 5 thiocyanato (SCN) group containing organic compound being read within the general formula I as claimed. Please see the whole disclosure of the applied reference, especially in the English language translation being labeled at claims 1 and 5, page 5 second paragraph with the general formula I, with n being 1 to 5 and R¹ being thiocyanato (SCN) group, page 20, line 23 and page 21, line 12. The language “emulsion layer being...thiocyanato compound” and “wherein Plug...PUG-S” are and have been considered as functional property of the materials. It has reasonable to believed that the functional property is inherent for the same compounds as broadly disclosed and claimed in the general formula I. The law requires that applicants must show or provide a convincing evidence to the contrary in accordance to the authority stated in In re Schreiber, 44 USPQ2d 1429. Since Stauffer et al disclose, teach, demonstrate and suggest the embodiments in the claims, the above claims are found to be anticipated by Renner et al.

V. In alternative to the anticipation in paragraph "I" above, claim 1-2, 4-9, 11-14 and 20 with respect to the applied species are rejected under 35 U.S.C. 103(a) as being obvious by Renner et al (DE 37 30 557) by the English language translation.

Renner et al disclose, teach and suggest a silver halide photographic material comprising a support having thereon an silver halide emulsion layer containing to more than 99 mol% silver chloride and from 1 to 5 thiocyanato (SCN) group containing organic compound being read within the general formula I as claimed. Please see the whole disclosure of the applied reference, especially in the English language translation being labeled at claims 1 and 5, page 5 second paragraph with the general formula I, with n being 1 to 5 and R¹ being thiocyanato (SCN) group, page 20, line 23 and page 21, line 12. The language "emulsion layer being...thiocyanato compound" and "wherein Plug...PUG-S" are and have been considered as functional property of the materials. It has reasonable to believed that the functional property is inherent for the same compounds as broadly disclosed and claimed in the general formula I. The law requires that applicants must show or provide a convincing evidence to the contrary in accordance to the authority stated in In re Schreiber, 44 USPQ2d 1429. Since Stauffer et al disclose,

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teach and suggest the embodiments in the claims with no demonstration or reduction to practice, in the alternative to the anticipation in the paragraph "I" above, the above claims are found to be rendered prima facie obvious by Renner et al.

VI. Claims 15-19 with respect to the applied species are rejected under 35 U.S.C. 103(a) as being obvious by Renner et al (DE 37 30 557) by the English language translation considered in view of Hirabayashi (5,270,156) and Lok (5,914,226).

Renner et al disclose, teach and suggest a silver halide photographic material comprising a support having thereon an silver halide emulsion layer containing to more than 99 mol% silver chloride and from 1 to 5 thiocyanato (SCN) group containing organic compound being read within the general formula I as claimed. Please see the whole disclosure of the applied reference, especially in the English language translation being labeled at claims 1 and 5, page 5 second paragraph with the general formula I, with n being 1 to 5 and R¹ being thiocyanato (SCN) group, page 20, line 23 and page 21, line 12. The language "emulsion layer being...thiocyanato compound" and "wherein Plug...PUG-S" are and have been considered as functional property of the materials. It has reasonable to believed

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that the functional property is inherent for the same compounds as broadly disclosed and claimed in the general formula I. The law requires that applicants must show or provide a convincing evidence to the contrary in accordance to the authority stated in *In re Schreiber*, 44 USPQ2d 1429.

Renner et al do not specify a conventional use in a range of a ratio of a coupler to silver as about those in claims 16 and 16. Hirabayashi et al at col.29:37-39 is cited to show the known teaching and suggestion of a range of a ratio of a coupler to silver as about those in the claims for the advantage of providing a color. There is no suggestion of a use of any coupler compound in Hirabayashi et al. The coupler compound is applied already in Renner et al primary reference.

Renner et al do not specify the use of a sulfinate-containing compound in claim 17-19. Lok at col.8:26 to 9:3 is cited to show the known use of the sulfinate containing compound to obtain stable photographic material having 95 or more mole percent silver chloride at col.1:7 and 10:6-17.

Since the above references are all related to silver halide color photographic materials, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the suggest range of a ratio of a coupler to silver for a reasonable expectation of obtaining a color image as suggested Hirayashi et al and to use or cite the suggested sulfinate containing compound for a

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reasonable expectation of obtaining a stable photographic material as suggested in Lok.

VII. Applicant's arguments filed 26 July 2005 have been fully considered but they are not persuasive.

In view of the showings under Rude 132 and arguments that complex inorganic-SCN does not release inorganic-S as claimed. Accordingly, the applied primary reference with respect to Stauffer et al (2,472,631) has been withdrawn. A complex inorganic-SCN is not considered.

The applied Renner et al above are not inorganic-SCN compounds as shown and urged but are organic-SCN compounds

VIII. Claims 3 and 10 are related to species being other than and broader than the elected compound 1 on the record. The above applied references do not specify them. They are properly withdrawn for now as being non-elected species. They will be considered when all of the applied species on the record are overcome.

IX. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

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The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
06 October 2005

HOA VAN LE
PRIMARY EXAMINER
